

**REMARKS**

**Formalities**

With this Amendment, Applicants amend Claims 33-35 and add new Claim 39. No new matter is added. Therefore, Claims 26-39 are all the claims currently pending in the present application.

Drawings. Figure 14 stands objected to for failure to include a “Prior Art” label. With this Amendment, Applicants add a “Prior Art” label to Figure 14 and respectfully request that the objection thereto be reconsidered and withdrawn.

Abstract. The Abstract stands objected to under MPEP §608.01(b) for containing greater than 150 words. With this Amendment, Applicants amend the Abstract to comply with MPEP §608.01(b) and respectfully request that the objection thereto be reconsidered and withdrawn.

Summary of the Invention. The Summary of the Invention section stands objected to under 37 C.F.R. § 1.73 as allegedly in non-compliance for excessive length and for including details of the inventive device, references to the figures, and references to the prior art. (Office Action, p. 3). Regarding this objection, Applicants submit that 37 C.F.R. § 1.73 does not impose any limit on the length of the Summary of the Invention Section, nor does it prohibit inclusion of details, comparison of the invention to the prior art, or reference to the drawings. The current Summary of the Invention does indicate the nature and substance of the invention, is commensurate with the invention as claimed, and thus is in full compliance with 37 C.F.R. § 1.73. Therefore, Applicants respectfully request that the objection to the Summary of the Invention section be reconsidered and withdrawn.

Disclosure. The disclosure stands objected to as requiring the phrase “, now U.S. Patent No. 6,747,801” after “January 12, 2001” in the first line of the disclosure, as amended in the Preliminary Amendment. The disclosure also stands objected to because the brief description of Figure 13 on page 10 is unclear. The disclosure also stands objected to as failing to provide proper antecedent basis for the claimed subject matter. The Examiner asserts that “The specification has not provided a positive support for the feature thereof ‘wherein a projected area ... not larger than 10%’ as recited in claim 35, last two lines of the claim.”

In view of these objections, Applicants amend the specification as shown. None of these amendments include new matter. Applicants respectfully request that the above-noted objections be reconsidered and withdrawn.

#### **Claim Objections**

Claim 33 stands objected to under 37 C.F.R. § 1.75(c) “because the range governing the range of inclination of the slope is larger than the range of inclination as recited in its base claim 26.” Claim 34 stands objected to under 37 C.F.R. § 1.75(c) “because the feature thereof ‘wherein said prismatic structure ... the other end thereof’ is unclear.”

With the current Amendment, Applicants amend Claims 33 and 34 as shown and respectfully request that the objections thereto be reconsidered and withdrawn.

#### **Claim 35 under 35 U.S.C. § 112, second paragraph**

Claim 35 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite for including the phrase “such as.” With this Amendment, Applicant amends Claim 35, as shown, and respectfully requests that the §112 rejection of Claim 35 be reconsidered and withdrawn.

**Obviousness-type Double Patenting**

Claims 26, 27, and 30-38 stand rejected under the judicially-created doctrine of obviousness-type double patenting over Claims 1-10 of U.S. Patent No. 6,659,615.

Without commenting on the substantive merits of the Examiner's rejection, but instead to expedite prosecution of the present Application, Applicants are submitting herewith a terminal disclaimer to obviate the above-noted obviousness-type double patenting rejection.

As noted in *Quad Environmental Technologies*, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting and raises neither presumption nor estoppel on the merits of the rejection. It is improper to convert this simple expedient of "obviation" into an admission or acquiescence or estoppel on the merits.<sup>1</sup>

**Claims 26, 28-31, 36, and 37 over Bao**

Claims 26, 28-31, 36, and 37 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Bao et al., EP 0867747, U.S. Patent No. 6,266,108 ("Bao"). Applicants respectfully traverse this rejection as set forth below.

Regarding claim 26, Bao fails to disclose or suggest a transparent film having an average in-plane retardation not larger than 30 nm, as recited. Regarding this limitation, the Examiner asserts that Bao describes a light guide made from acrylic resin, which is a material described in the specification of the present invention as an optional material for the transparent film of the present invention.

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<sup>1</sup> *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ.2d 1392, 1394, 1395 (Fed. Cir. 1991).

It appears, therefore, that the Examiner is asserting that the limitation of in-plane retardation not larger than 30 nm is inherent to the disclosure of Bao. Applicants note that evidence of inherency in a reference “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”<sup>2</sup> Further, inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”<sup>3</sup> Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not *necessarily* present in the prior art disclosure.<sup>4</sup> It is Applicants’ understanding that an acrylic resin does not *necessarily* have in-plane retardation not larger than 30 nm. Thus, even assuming *arguendo* that light guide of Bao were formed from acrylic resin, the above-mentioned limitation is not *inherent* to the disclosure of Bao.

In view of the above, Applicants submit that Bao fails to anticipate Claim 26, and therefore, that Claims 28-31, 36, and 37 are patentable at least by virtue of their dependence on Claim 26. Therefore, Applicants respectfully request that the rejection of Claims 26, 28-31, 36, and 37 be reconsidered and withdrawn.

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<sup>2</sup> *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

<sup>3</sup> *Id.* (citing *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))); *see also Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

<sup>4</sup> *See Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

**Claims 27, 32-35, and 38**

Claims 27 and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bao, in view of Ishimaru, JP 11-142618 (“Ishimaru”). Claims 33 and 35 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bao, in view of Qiao et al., U.S. Patent No. 5,485,291 (“Qiao”). Claims 32 and 34 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bao, in view of Umemoto et. al., U.S. Patent No. 5,727,107 (“Umemoto”).

Regarding these rejections, Applicants note that Ishimaru, Qiao, and Umemoto fail to remedy the deficiencies of Bao, as discussed above with respect to Claim 26, and therefore, Claims 27, 32-35, and 38 are patentable at least by virtue of their dependence on Claim 26. Applicants therefore respectfully request that the rejection of Claims 27, 32-35, and 38 be reconsidered and withdrawn.

**New Claim 39**

With this Amendment, Applicants add new Claim 39 in order more fully to cover various aspects of Applicants’ invention as disclosed in the specification. Applicants submit that Claim 39 is supported in the originally-filed specification at least at page 21, line 14 to page 24, line 4. Applicants respectfully submit that Claim 39 is patentable at least by virtue of its dependence on Claim 26, discussed above.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 10/735,209

Q78829

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Laura Moskowitz  
Registration No. 55,470

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: July 13, 2005

**AMENDMENTS TO THE DRAWINGS**

**Please replace Figure 14 with the attached, replacement Figure.**

Attachment: One (1) Replacement Sheet